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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/910,115	08/13/1997	BAYCHAR	BAY-310	2266
24956	7590	03/15/2004		
MATTINGLY, STANGER & MALUR, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			EXAMINER JUSKA, CHERYL ANN	
			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 08/910,115	Applicant(s) BAYCHAR,	
	Examiner Cheryl Juska	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-10,13,17,20-32,34,36-38,40-42 and 44-110 is/are pending in the application.
- 4a) Of the above claim(s) 8-10,13,25-32,34,36-38,40-42,44-88 and 91-109 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,17,20-24,89,90 and 110 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/02, 10/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group II, species A(a) and B(a) in the paper filed November 25, 2003, is acknowledged. Thus, claims 1-4, 7, 17, 20-24, 89, 90, and 110 will be examined, while claims 8-10, 13, 25-32, 34, 36-38, 40-42, 44-88, and 91-109 are withdrawn as non-elected.

### ***Information Disclosure Statement***

2. The information disclosure statement filed June 7, 2002, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Specification***

3. The use of the trademarks have been noted in this application. They should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

Art Unit: 1771

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 7, 22, 24, and 90 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 7 limits the outer moisture transfer material to being a fabric that is structurally knitted or woven to repel water. However, claim 7 depends from claim 1, which limits said outer material to being treated by encapsulation for waterproofing. The specification, page 10, lines 7-9, states, "The structurally woven or knitted fabrics do not require encapsulation or breathable membranes to waterproof the garment." Thus, claims 7, 22, 24, and 90 are contrary to the disclosure of the invention and constitute new matter.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 1771

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 17, and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,048,810. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art to eliminate the second foam layer in order to produce a thinner product, while maintaining the moisture transport properties of the composite laminate.

8. Claims 1, 20, 21, 23, 89, and 110 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,048,810. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art to add an outer layer in order to provide an attractive and durable outer surface. Additionally, it would have been obvious to one skilled in the art to make said outer layer breathable (i.e., providing moisture transport) and waterproof in order to allow perspiration to escape while preventing water from penetrating the laminate.

9. Claims 1 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 17, and 23 of copending Application No. 08/887847.

Claim 21 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8 and 25 of copending Application No. 08/887847.

Art Unit: 1771

Claim 23 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11, 26, and 29 of copending Application No. 08/887847.

Claim 110 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 of copending Application No. 08/887847.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art to employ the moisture transfer composite of 08/887,847 as an apparel, as is presently claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 27 of copending Application No. 08/887847. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art to employ the moisture transfer composite of 08/887,847 as an apparel, as is presently claimed. Additionally, it would have been obvious add an outer layer in order to provide an attractive and durable outer surface. Furthermore, it would have been obvious to one skilled in the art to make said outer layer breathable (i.e., providing moisture transport) and waterproof in order to allow perspiration to escape while preventing water from penetrating the laminate.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,431,970 issued to Broun et al.

Broun discloses a three layer laminate comprising (a) a hydrophilic inner layer for wicking moisture from an interior, (b) an open-cell foam attached to the inner layer for receiving said moisture, and (c) a hydrophobic outer layer attached to the foam layer for allowing said moisture to evaporate therethrough and to prevent water from penetrating inward to the foam and inner layers (abstract). The hydrophobic outer layer may be a woven or nonwoven fabric having a sufficiently small pore size (i.e., microporous) to prevent penetration of water, while allowing passage of water vapor (col. 4, lines 59-63). Broun teaches a few specific fabrics for said outer layer, but also states, "there are many other fabrics which are suitable so long as they satisfy the criteria discussed above" (col. 5, lines 11-13).

Thus, Broun teaches the invention of claim 20 with the exception that the outer hydrophobic layer is made waterproof by encapsulation. However, encapsulated, breathable, waterproof fabrics are well-known in the art. For example, Cordura®, by Du Pont, is one of many well-known fabrics that are encapsulated to provide water resistance and breathability. Applicant is hereby given Official Notice of this fact. (Additionally,

Art Unit: 1771

note applicant's own admission of known encapsulated fabrics including Cordura® in the specification, page 8.) Therefore, it would have been obvious to one of ordinary skill in the art to substitute a known waterproof, breathable fabric that has been treated with encapsulation for the waterproof, breathable outer layer of Broun, since Broun teaches other fabrics are suited for the outer layer as long as the criteria of water resistance and breathability are met.

13. With respect to applicant's limitation that the invention is apparel, it is argued that this limitation is merely descriptive of intended use. As such, this limitation is not given patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In the alternative, upon giving said limitation weight, it is argued that it would have been obvious to one of ordinary skill in the art to employ the laminate material of Broun, which is suitable for a bag or case, as an apparel. Motivation to do so would be to expand the number of applications of the Broun invention. Therefore, claim 20 is rejected as being obvious over the prior art.

14. Claims 1-4, 7, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,431,970 issued to Broun et al.

Broun teaches the invention of claims 1-4, 7, and 17 with the exception of (a) the nonwoven layer, (b) encapsulation of outer layer, and (c) apparel. The arguments presented above with respect to the encapsulation and apparel limitations are also valid



Art Unit: 1771

for claims 1-4, 7, and 17. With respect to the nonwoven layer, it is argued this limitation would also have been obvious to one skilled in the art. Specifically, foams having attached nonwoven carrier layers are known in the art. Applicant is hereby given Official Notice of this fact. As such, it would have been obvious to a person having ordinary skill in the art to utilize a foam having a nonwoven carrier substrate as the foam of Broun in order to provide improved dimensional stability and reinforcement. The examiner notes that the facts asserted to be common and well-known are capable of instant and unquestionable demonstration as being well-known. To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.

With respect to claim 7, it is noted that Broun explicitly teaches the hydrophobic outer layer may be a woven or nonwoven fabric having a sufficiently small pore size (i.e., microporous) to prevent penetration of water, while allowing passage of water vapor (col. 4, lines 59-63). In other words, the fabric may be a woven fabric that is structurally woven to repel water. Therefore, claims 1-4, 7, and 17 are rejected as being obvious over the cited prior art.

15. Claims 21-24, 89, 90, and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,431,970 issued to Broun et al. in view of US 5,637,389 issued to Colvin et al.

Broun does not teach any of the layers being treated with microencapsulation technology in order to provide reversible enhanced thermal properties. However, Broun does teach the invention is employed for bags or cases for carrying and storing

Art Unit: 1771

equipment, such as cameras, video equipment, scientific instruments, and military devices (col. 1, lines 16). Additionally, Broun teaches said storage bags are subjected to adverse physical conditions, such as exposure to high temperatures. Thus, one skilled in the art would be motivated to improve the insulating properties of the Broun invention in order to protect equipment being stored.

One such method of providing insulating properties includes the invention of Colvin. Specifically, Colvin teaches a foamed insulation material for applications such as clothing and packaging (col. 1, lines 13-21). Said foamed insulation comprises microencapsulation of a foam material, wherein said microcapsules contain a phase change material for providing reversible thermal properties (abstract). Thus, it would have been obvious to one skilled in the art to provide treat the foam layer of Broun with a microencapsulation treatment in order to provide insulation to the equipment being stored. Therefore, claims 21-24, 89, 90, and 110 are rejected as being obvious over the cited prior art.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 1771

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHERYL A. JUSKA  
PRIMARY EXAMINER

cj  
March 5, 2004